

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Keith A. Kozak et al. ) Examiner: Anatoly Vortman  
Serial No.: 08/953,154 ) Group Art Unit: 2835  
Filed: October 17, 1997 ) Docket: 450.154US1  
For: MODULAR COMPUTER DEVICE AND COMPUTER KEYBOARD FOR  
MODULAR DEVICE )

**APPEAL BRIEF TO THE BOARD OF  
PATENT APPEALS AND INTERFERENCES OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

MS APPEAL BRIEF - PATENTS  
Commissioner for Patents  
Washington, D.C. 20231

**APPELLANTS' BRIEF ON APPEAL**

This brief is presented in support of the Notice of Appeal mailed February 24, 2004, and received by the PTO mail room on March 1, 2004, from the Final Rejection of claims 1-11, 13-18, 20 and 21 of the above identified application, as set forth in the Final Office Action mailed September 24, 2003. Nineteen claims remain for consideration. The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

The requisite fee of \$340.00 as set forth in 37 C.F.R. § 1.17(c) is enclosed. Appellant reserves the right to submit a request for an oral hearing at a later time. Although other fees are not expected, Appellant authorizes the Examiner to charge or credit Deposit Account 50-0439 as necessary.

**1. REAL PARTY IN INTEREST**

The present application has been assigned to Gateway, Inc., a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having an office and place of business at 610 Gateway Drive, P.O. Box 2000, North Sioux City, SD 57049-2000, in an assignment recorded on October 17, 1997, (Reel /Frame: 8781/0625).

**2. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellant which will have a bearing on the Board's decision in the present appeal.

**3. STATUS OF THE CLAIMS**

Claims 1-11, 13-18, 20 and 21 are pending and are all presently at least twice rejected. These nineteen claims are the subject of the present appeal (see Appendix I for a list of the claims on appeal).

**4. STATUS OF AMENDMENTS**

No Amendments have been filed subsequent to the September 24, 2003 Final Office Action. The claims are, therefore, in the form they were in after the Amendment and Response filed by Appellant on July 28, 2003. The claims listed in Appendix I reflect the current state of the pending claims.

**5. SUMMARY OF CLAIMED SUBJECT MATTER**

The invention as claimed describes a non-integral keyboard (FIGs 1-2 16, FIG 3A 24, page 5, line 18 – page 8, line 7) for a personal computer (10) having a communications link, such as a serial cable, and a connector (FIG 3A 86, FIG 3B 34, page 8, line 8 – page 11, line 8) within

the housing. The connector is receptive to a corresponding connector of a device such as a PDA (22). The device communicates with the computer over the communications link when the connectors are coupled.

The keyboard in one embodiment includes an integrated cradle for the docking of modular devices such as PDA devices. A stand-alone cradle that consumes scarce desk-top real estate is not necessary. Furthermore, in a preferred embodiment in which there is a single cable (such as a Universal Serial Bus cable) between the inventive keyboard and the computer to which it is coupled, an additional cable is not required for the cradle. This promotes easier cable management.

Furthermore, the invention as claimed describes a novel modular computer device (FIG. 4A, 4B 52, page 14, line 14 – page 7, line 4) operable in a docking mode when it is connected to a computer peripheral such as a keyboard, and in a stand-alone mode when it is not connected to the peripheral. The device includes a controller defining at least one changeable virtual key on a touch screen of the device. An integrated wireless transceiver permits the device to communicate with the computer when operating in the stand-alone mode.

The changeable virtual keys of the novel modular device in effect extend the capabilities of the keyboard when the device is docked to the keyboard. The keys, for example, may change depending on the application actively running on the computer, in which case they are effectively automatic customized function keys. When the device is operating in the stand-alone mode, it acts as a changing customizable (dynamic) remote control device for the computer.

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to the appended claims and their legal equivalents for a complete statement of the invention.

## **6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-11, 13-18, 20 and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kikinis et al. (US 5,83,732).

## **7. ARGUMENT**

### **I) Rejections under 35 U.S.C. § 102(e)**

#### ***a) The Applicable Law***

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P. § 2131*. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

#### ***b) Discussion of the Rejections***

Claims 1-11, 13-18, 20 and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kikinis et al. (US 5,835,732). Appellant respectfully traverses the rejection and submit that the Final Office Action did not make out a prima facie case of anticipation because the cited reference does not disclose each and every element in Appellant’s claims. Additionally, the identical claimed invention is not disclosed and the elements of Kikinis are not arranged as in Appellants’ claims.

A first example of an element not disclosed in Kikinis is found in claim 1 which recites a connector operatively coupled to the communications link, said connector disposed within the

housing.” Claims 17 and 20 recite similar language. The Final Office Action asserts that connector 14' of FIG. 6 of Kikinis is a connector disposed within the housing, Appellant respectfully disagrees with this assertion. FIG. 6 illustrates that connector 14' is disposed on host computer 66. Further, Kikinis at column 10, lines 8-25 states that input device 60 of FIG. 6 maybe a keyboard. It is clear from this description that input device 60 is a separate element of host computer 66. FIG. 6 also clearly shows that connector 14' is not disposed within input device 60. As a result, Kikinis does not disclose that connector 14' is disposed within a housing for a keyboard, rather Kikinis illustrates that connector 14' is disposed on a host computer 66. The Final Office Action asserts that the laptop illustrated in FIG. 5 shows a housing containing the elements discussed above. However, Appellant's claims recited that the housing defines a “non-integral personal computer keyboard.” The laptop illustrated in FIG. 5 does not show a housing defining a non-integral personal computer keyboard as recited in Appellant's claims. Rather, the housing depicted in FIG. 5 is a laptop housing. The Office Action attempts to make up for this deficiency by referring to keyboard 151 in FIG. 20. However, the keyboard illustrated in FIG. 20 contains none of the elements recited in Appellant's claims. In fact, connector 153 in keyboard 20 is shown as being external to the keyboard, not disposed within the keyboard as recited in Appellant's claims.

In view of the above, Appellant respectfully submits that Kikinis does not disclose the identical claimed invention as arranged in Appellant's claims. Appellant further submits that Kikinis does not disclose a connector disposed within a housing for a non-integral personal computer keyboard and therefore does not disclose each and every element of Appellant's claims. Appellant therefore respectfully requests the reversal of the rejection of claims 1, 17 and 20.

Claim 2 depends from claim 1 and further recites that “the housing has a plurality of surfaces defining a cradle cavity into which the connector is disposed, the cradle cavity shaped so that the device fits into the cavity such that at least one surface of the device is exposed.” The Final Office Action asserts that Kikinis at FIG. 5 discloses the recited language, Appellant

respectfully disagrees with this assertion. Kikinis at FIG. 5 illustrates a notebook computer 172 having a Type II PCMCIA docking port 105. As argued above, the notebook computer illustrated in FIG. 5 is not a housing for a non-integral personal computer keyboard, as recited in claim 1 and inherited by claim 2. Thus the notebook housing illustrated in FIG. 5 is different from a non-integral keyboard housing recited in Appellant's claims. Nowhere does Kikinis teach a non-integral keyboard having a plurality of surfaces forming a cradle cavity. Further, claim 2 recites that the device fits into the cavity such that at least one surface is exposed. Kikinis is silent as to how the device fits into the docking bay of the laptop computer shown in FIG. 5. As a result, Kikinis does not teach each and every element of claim 2, Appellant respectfully requests the reversal of the rejection of claim 2.

Claims 3 and 4 depend from claim 2 (and indirectly from claim 1). Claim 18 depends from claim 17. These dependent claims are therefore not anticipated for the reasons discussed above with regard to their respective base claims 1, 2 and 17. Appellant respectfully requests the reversal of the rejection of claims 3, 4 and 18.

Claim 5 depends from claim 2 and further recites that "at least one of a top surface and a bottom surface of the device is flush with a corresponding surface of the housing. Claim 21 depends from claim 20 and recites similar language. The Final Office Action asserts that the recited language is "inherited in the structure, since the device (10) is inserted in a docking bay." Appellant respectfully disagrees with this interpretation of Kikinis. If the device is inserted into a docking bay, it may be wholly surrounded by the docking bay or a portion of the device may extend outside of the docking bay. Even assuming that Kikinis disclosed a cradle cavity within a housing for a non-integral keyboard (which as argued above is not the case), it is not inherited (nor inherent) in the structure of Kikinis that a surface of the device is flush with the surface of a keyboard housing. As a result, Kikinis does not teach or disclose each and every element of claim 5. Appellant respectfully requests the reversal of the rejection of claim 5 and 21.

Claims 6 - 11, 13, 15 and 16 depend directly or indirectly from claim 1. They are therefore not anticipated for the reasons discussed above with respect to claim 1. Appellant respectfully requests the reversal of the rejection of claims 6- 11, 13, 15 and 16.

Additionally, with respect to claim 16, Appellant notes that device 10 is inserted into a telephone handset. In Appellant's claim 16, the device is a telephone handset that is inserted into the cavity of a non-integral keyboard. Thus the Office Action appears to be using the telephone handset to equal two different items in Appellants claims, the device itself and the keyboard. In order for this interpretation to be correct, the handset (device) would have to be insertable in the handset (non-integral keyboard). In other words, the handset would have to be insertable in itself, which is clearly not possible. Appellant therefore respectfully requests the reversal of the rejection of claim 16.

Claim 14 depends from claim 1 and further recites "the device is a touch screen device having at least one changeable virtual key." As defined in Appellant's specification the changeable virtual keys in effect extend the capabilities of the keyboard when the device is docked to the keyboard and that such keys are programmed in accordance with computer software applications running on the computer, and change in accordance with the active application on the computer. Thus the virtual key of the present invention interacts with the host computer. In contrast, the softkey disclosed in Kikinis does not interact with the host computer; rather it is a softkey operable on the PDA itself. As a result, Kikinis does not disclose the virtual key operation as the term "virtual key" is defined in Appellants specification. Appellant respectfully requests the reversal of the rejection of claim 14.

**APPEAL BRIEF**

Serial No. 08/953,154

Filed: October 17, 1997

Title: MODULAR COMPUTER DEVICE AND COMPUTER KEYBOARD FOR MODULAR DEVICE

---

Page 8

Atty. Docket 450.154US1

**8. CONCLUSION**

For the above reasons, claims 1-11, 13-18, 20 and 21 were not properly rejected under 35 U.S.C. § 102(e) as being anticipated by Kikinis et al. (US 5,835,732).

It is respectfully submitted that the art cited does not anticipate the claimed invention and that therefore the claimed invention does patentably distinguish over the cited art. It is respectfully submitted that claims 1-11, 13-18, 20 and 21 should therefore be allowed. Reversal of the Examiner's rejections of claims 1-11, 13-18, 20 and 21 is respectfully requested. Should the Board be of the opinion that a rejected claim may be allowable in amended form, an explicit statement to that effect is also respectfully requested.

Respectfully submitted,

KEITH A. KOZAK ET AL.

By their Representatives,

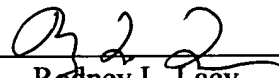
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 373-6954

Date October 1, 2004

By   
Rodney L. Lacy  
Reg. No. 41,136

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS APPEAL BRIEF - PATENTS, Commissioner of Patents, Washington, D.C. 20231, on this 1 day of October, 2004.

Name Rodney L. Lacy

Signature 



**APPENDIX I**

**The Claims on Appeal**

1. (Previously presented)      A keyboard comprising:
  - a housing defining a non-integral personal computer keyboard;
  - a plurality of keys disposed within the housing;
  - a communications link disposed within the housing, wherein the communications link is capable of communicating with a computer; and,
  - a connector operatively coupled to the communications link, said connector disposed within the housing and receptive to a corresponding connector of a device such that the device communicates with the computer over the communications link when the connectors are coupled.
2. (Original)    The keyboard of claim 1, wherein the housing has a plurality of surfaces defining a cradle cavity into which the connector is disposed, the cradle cavity shaped so that the device fits into the cavity such that at least one surface of the device is exposed.
3. (Original)    The keyboard of claim 2, wherein the cradle cavity is shaped so that the device fits into the cavity such that at least a front surface of the device is exposed.
4. (Original)    The keyboard of claim 2, wherein the cradle cavity is shaped so that the device fits into the cavity such that at least a top surface of the device is exposed.
5. (Original)    The keyboard of claim 1, wherein the housing has an end surface into which the connector is disposed, the connector of the device coupling the connector of the housing such that at least one of a top surface and a bottom surface of the device is flush with a corresponding surface of the housing.

6. (Original) The keyboard of claim 1, wherein the communications link comprises at least a cable.
7. (Original) The keyboard of claim 6, wherein the cable is a Universal Serial Bus (USB)-compatible cable.
8. (Original) The keyboard of claim 6, wherein the communications link also comprises at least a radio frequency (RF) transceiver.
9. (Original) The keyboard of claim 1, further comprising a recharger operatively coupled to the connector of the keyboard to recharge a battery of the device when the connectors are coupled.
10. (Original) The keyboard of claim 1, further comprising a power source disposed within the housing.
11. (Original) The keyboard of claim 1, wherein the device is a personal digital assistant (PDA) device operable in a docking mode when the connectors are coupled and operable in a stand-alone mode when the connectors are uncoupled.
12. (Cancelled)
13. (Original) The keyboard of claim 1, wherein the device communicates with the computer in a docking mode when the connectors are coupled and in a stand-alone mode via a wireless transceiver of the device communicating with a corresponding wireless transceiver of the computer.

14. (Original) The keyboard of claim 1, wherein the device is a touch screen device having at least one changeable virtual key.

15. (Original) The keyboard of claim 1, wherein the device includes a power source.

16. (Original) The keyboard of claim 1, wherein the device is selected from the group of devices comprising a remote control for a television, a digital video disc (DVD) player, a compact disc (CD) player, and a telephone handset.

17. (Previously presented) A keyboard comprising:

a housing defining a non-integral personal computer keyboard;

a plurality of keys disposed within the housing;

a communications link disposed within the housing to communicatively couple the keyboard to the computer; and,

a communications link disposed within the housing, wherein the communications link is capable of communicating with a computer; and,

a connector disposed within the housing and receptive to a corresponding connector of a personal digital assistant (PDA) device such that the PDA device communicates with the computer over the communications link when the connectors are coupled.

18. (Original) The keyboard of claim 17, wherein the housing has a plurality of surfaces defining a cradle cavity into which the connector is disposed, the cradle cavity shaped so that the PDA device fits into the cavity such that at least one surface of the device is exposed.

19. (Cancelled)

20. (Previously presented) A keyboard comprising:

a housing defining a non-integral personal computer keyboard;

a plurality of keys disposed within the housing;

a communications link disposed within the housing, wherein the communications link is capable of communicating with a computer; and,

a connector disposed within the housing and receptive to a corresponding connector of a device having a touch screen such that the device communicates with the computer over the communications link when the connectors are coupled.

21. (Original) The keyboard of claim 20, wherein the housing has an end surface into which the connector is disposed, the connector of the device coupling the connector of the housing such that at least one of a top surface and a bottom surface of the device is flush with a corresponding surface of the housing.

22.-28. (Cancelled)